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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/954,621	09/17/2001	Jerry G. Hodsdon	67134-5040	6827

7590 12/12/2007
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EXAMINER

AHMAD, NASSER

ART UNIT	PAPER NUMBER
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1794

MAIL DATE	DELIVERY MODE
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12/12/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 09/954,621	Applicant(s) HODSDON ET AL.	
	Examiner Nasser Ahmad	Art Unit 1794	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 9/13/2007, 9/27/2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) See Continuation Sheet is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 198-203, 207-216, 220-223, 231, 232, 246-249 and 251-254 is/are allowed.
- 6) ☒ Claim(s) 134, 136, 139, 140, 143, 144, 146, 148-153, 156-161, 174-178, 182-190 and 193-197, 224-230, 233-245, 250, 255-280 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Continuation of Disposition of Claims: Claims pending in the application are 134,136,139,140,143,144,146-153,156-161,174-178,182-190,193 and 195-280.

DETAILED ACTION

Rejections Maintained

1. Claims 148-153, 156-161 are rejected under 35 U.S.C. 103(a) as being unpatentable over La Mers for reasons of record made in the Office Action of 6/13/2007.

Rejections Withdrawn

2. Claims 185-197 are rejected under 35 U.S.C. 112, first paragraph, made in the Office Action of 6/13/2007 has been withdrawn in view of the amendment filed on 9/13/2007 and 9/27/2007.
3. Claims 134, 137-139, 142-147, 162, 164-165, 168-174, 176-177, 180-185, 188-189, 192-198, 200-202, 205-212, 214-215, 218-223 are rejected under 35 U.S.C. 102(b) as being anticipated by La Mers (4,454,180) made in the Office Action of 6/13/2007 has been withdrawn in view of the amendment filed on 9/13/2007 and 9/27/2007.
4. Claims 135-136, 140-141, 148-161, 163, 166-167, 175, 178-179, 186-187, 190-191, 199, 203-204, 213, 216-217 are rejected under 35 U.S.C. 103(a) as being unpatentable over La Mers made in the Office Action of 6/13/2007 has been withdrawn in view of the amendment filed on 9/13/2007 and 9/27/2007.

Response to Arguments

5. Applicant's arguments with respect to claims 134, 136, 139-140, 143-144, 146, 174-190, 193, 195-203, 207-216, 220-223 and new claims 224-244 (in amendment filed

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on 9/13/2007) and new claims 245-280 (in amendment filed on 9/27/2007) have been considered but are moot in view of the new ground(s) of rejection.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 134, 136, 139-140, 143-144, 146, 174-178, 182-190, 193, 195-197, 228-229, 233-234, 237-238, 255-256, 258-261, 263-269, 271-274, 276-280 are rejected under 35 U.S.C. 103(a) as being unpatentable over La Mers.

La Mers relates to a label sheet construction (190) comprising a liner sheet (126), a facestock sheet (192) adhered to the liner sheet, at least one first cut line (cut line surrounding label 146) through the facestock sheet but not the release coated liner sheet to form an entire perimeter of a facestock sheet first label releasably adhered to the liner sheet, at least one second cut line (cut line surrounding label adjacent to label 146) through the facestock sheet to form a facestock sheet second label releasably adhered to the liner sheet, the second label being spaced from the first label and separated therefrom a label-free waste portion of the facestock, an elongate weakened line (196) in the label-free waste portion of the facestock sheet outside of and extending linearly straight between the first label and the second label. The elongate weakened

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line lying in a defining line which is in the facestock sheet, which extends from one edge of the facestock sheet to another edge of the facestock sheet and which passes through the first and second labels. As shown in figures 16 and 18, the defining line in the first and second labels being free of the weakened facestock line segments. However, La Mers fails to teach that the weakened line is spaced a short distance from the label by a short uncut line. It is noted that La Mers, in col. 9, lines 30-35, teaches the presence of fine bridging filaments or paper between the label and the matrix material and which is still present despite die-cutting. This feature of the presence of fine bridging filament or paper is interpreted to be the short uncut section of the facestock sheet. Therefore, it would have been obvious to one having ordinary skill in the art to modify La Mers by providing the weakened line to be a die-cut line with uncut portions for facilitating retention of the labels in the matrix while providing removability of the label thereof.

The phrase "the liner sheet **being constructed** so as **to be capable of** being bent back on the defining line to thereby separate the liner sheet away from a portion of the first label such that the portion of the first label **can be grasped** and the first label **can be peeled** off of the liner sheet" has not been given patentable weight because it only requires the ability to so perform and is not deemed to be of positive limitation.

For claim 136, wherein an end of the elongate weakened line closest to the second label is spaced a short distance therefrom by a short uncut section of the facestock sheet, would have been obvious because La Mers, in col. 9, lines 30-35, teaches the presence of fine bridging filaments or paper between the label and the matrix material and which is still present despite die-cutting. This feature of the presence of fine bridging filament or paper is interpreted to be the short uncut section of the facestock

sheet.

For claim 139, the label construction further comprising the elongate weakened line defining a first elongate weakened line, and a second elongate weakened line extending between the first label and an edge of the facestock sheet, the second elongate weakened line lying in the defining line (figure- 16 shows the presence of first and second weakened lines, lying in the defining line and located between an edge and the first label, and between the first and second labels, respectively).

As for claim 140, the label having a burst shape would have been obvious design choice for change of shape of the label.

For claim 143, the liner sheet has a silicone coating , and a layer of adhesive is sandwiched between the facestock sheet and the silicone coating (col. 3, lines 50-55).

Regarding claim 144, the label line is spaced from and parallel to the defining line (because the label line is separated from the defining line by a short uncut portion as discussed in La Mers, col. 9, lines 30-35).

For claim 146, a label-free waste matrix of the facestock sheet surrounds the first and second labels (figure-16, portions outside of the labels are taken to be label-free matrix).

Regarding claim 174, the size dimension of the label sheet would have been obvious matter of design choice as to modify the size in La Mers to provide for maximum area for information display.

For the phrases “being constructed **to be sheet-fed through a printer or copier to print** indicia on the label **to form** a printed label on the liner sheet”, “the label sheet construction **being structured** such that with the liner sheet bent back on the fold line the line sheet is separated away from a portion of the label to a label portion to a label portion **graspable condition**, and the liner sheet is folded on a fold line of the liner sheet without being separated on the liner sheet fold line” are directed to an indented

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use of the label. These are not found to be of positive limitation, and hence, have not been given any patentable weight.

For claim 185, the center point of the labels are spaced from the defining line (because of the presence of a short uncut portion as discussed in La Mers, col. 9, Lines 31-35).

For the intended use phrase "**being configurable in a first configuration...second configuration...graspable positions**", it has not been given patentable weight because said phrase is not found to be of positive limitation.

For claim 233, the straight line defining a fold line of the label sheet construction (the straight line La Mers is shown to be a fold line as it folds during the labeling process.

For the phrase "the label sheet construction **being configurable** to a label-portion **graspable condition** wherein a portion of the first label is separated from the liner sheet generally at the fold line with the liner sheet bent back generally on the fold line" is found to be directed to an intended use of the label construction and is not given any patentable weight as it is not found to be of positive limitation.

As for claim 237, the intended use phrase "the label sheet **being configurable in a first configuration...alternative second configuration ...graspable position**" has not been given patentable weight because it is directed to an intended use of the label from a first configuration to a second configuration.

For claim 246, the label to have a rectangular shape, it would have been obvious matter of design choice to modify La Mers by changing the circular shape to a rectangular shape, as a change in shape is found to be within the level of ordinary skill in the art.

Claim Rejections - 35 USC § 112

8. The following is a quotation of the first paragraph of 35 U.S.C. 112:

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The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

9. Claims 224-227, 235-236, 239-245, 250, 257, 262, 270, 275 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

For claims 224-227, the phrase "an entire area of the liner sheet under the label forms an **undivided area** of the liner sheet" is found to be new matter as support for said phrase could not be located in the originally filed specification and applicant also failed to show as to the support for said phrase.

For claims 235, 239, the phrase "the weakened line segment **not penetrating** through the exposed back surface of the liner sheet" is found to be new matter as the negative language changes the scope of the invention, in that the degree of penetration of the weakened line segment is not disclosed.

Regarding claims 241, 243, the phrase "the liner sheet being free of weakening lines under the label and aligned with the label" is deemed to be new matter for lack of support therefor in the originally filed specification.

For claims 245, 250, 257, 262, 270, 275 the specification fails to provide support for the phrase "the liner sheet is wider than the facestock sheet and extends out from both side edges thereof" and hence, this phrase is found to be new matter. Support for said phrase in para-0019 could not be located as directed by the applicant.

Response to Arguments

10. Applicant's arguments filed 9/13/2007 and 9/27/2007 have been fully considered but they are not persuasive.

Applicant argues that *At the bottom of page 5 of the Office Action, the Examiner stated that the phrases "capable of" and "being configurable" were not "positive limitations" and hence, the Examiner did not give them any "patentable weight." In other words, he accorded those features no patentable weight; and he did not contend that those features presented 112, 102 or 103 issues, he simply ignored them. Further, the Examiner did not cite or refer to any section of the MPEP or to any case law for this claim construction technique.* This is not found to be convincing because the claims are directed to a product claim such as a label sheet construction. Contrary to applicant's position, the claims are not directed to a method of using the claimed product. Hence, the phrases such as **"capable of"**, **"being configurable"**, **"graspable condition"**, **"can be grasped"**, etc. are directed to conditions wherein the product is used. These phrases are directed to an intended use or intended future use of the claimed construction product. Therefore, applicant should note that claims directed to product must be distinguished from the prior art in terms of the structure rather than function, for example a product claim covers what a product is, and not what the product does.

In response to applicant's citing of seven exemplary case laws in the amendment, pages 25-26, applicant is informed that none of the cases laws cited are directed to a label sheet construction.

Regarding applicant's arguments that the "obvious duplication of parts" rejection is improper, applicant should note that claim 148 is directed to the presence of two lines

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(comprising first and second segments, and third and fourth segments, respectively).

So, the presence of the second of said line is found to be obvious duplication of parts because the presence of a second such line would provide for increased flexibility to the label construction.

As for the argument by the applicant that “negative limitations are not indefinite, applicant is informed that none of the rejection address the negative limitation as indefinite. Rather, the negative limitation are found to be new matter for lack of support therefor in the originally filed specification. Additionally, it is noted that said negative limitation also changes the scope of the claimed invention , in that it claims the invention by reciting was the applicant did not invent as opposed to what the applicant did invent.

In response to applicant’s argument that La Mers cannot be modified to render claims 134 and 148, as amended, obvious because the uncut portion “**may result**” in tearing, it is noted that applicant is attempting to distinguish the applied prior art by the intended use of the claimed product and not the structural distinction thereof.

As for claim 174, applicant’s argument that a fold line is not disclosed in La Mers is noted. However, the presence of the cut or weakened line would provide for the foldability.

As for applicant’s argument for claim 185, applicant has failed to show that, based on obvious duplication of parts, the presence of additional lines would not be offset from the center of the label.

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Applicant's argument that the feature of claim 198 is disclosed in para-0018 is noted.

However, said feature that the weakened line segment is "to the liner sheet, but not through it" could not be located in said para-0018.

For claim 212, the above explanation apply *a fortiori* herein.

As for claim 233, applicant should note that it would have been obvious to modify Lamers to have a plurality of rows and columns of the facestock material, as obvious duplication of parts. This is because the label sheet construction is known to be manufactured in multiple rows and columns for economic purpose and then a single row is cut therefrom for a particular apparatus.

Finally, applicant argues that nine actions have been received by the applicant. In response, applicant is directed to the file history of the application, wherein the applicant filed a RCE after every FINAL Office Action. For example, the RCEs were filed after second, fourth, sixth and eighth Office Actions.

Allowable Subject Matter

11. Claims 198-203, 207-216, 220-223, 231-232 allowed.

The prior art fails to teach or suggest that the weakened line segment is in the facestock sheet and not through the liner sheet.

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Conclusion

12. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).


A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nasser Ahmad whose telephone number is 571-272-1487. The examiner can normally be reached on 7:30 AM to 5:00 PM, and on alternate Friday.


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rena Dye can be reached on 571-272-3186. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.


Nasser Ahmad 12/7/07
Primary Examiner
Art Unit 1794

N. Ahmad.
December 7, 2007.


RENA DYE
SUPERVISORY PATENT EXAMINER
AU 1794